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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 09/871,030 | 05/31/2001 | David Henry | SP00-189 | 8153 |
| 22928 | 7590 | 02/25/2004 | EXAMINER | |
| CORNING INCORPORATED | | | PENG, KUO LIANG | |
| SP-TI-3-1 | | | | |
| CORNING, NY 14831 | | | ART UNIT | PAPER NUMBER |

1712

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/871,030

Applicant(s)

HENRY ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/31/03 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-45 is/are allowed.
- 6) ☒ Claim(s) 1-4, 27-29 and 34-36 is/are rejected.
- 7) ☒ Claim(s) 5-26, 30-33 and 37-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The Applicants' amendment filed on December 31, 2003 was received. Claims 1, 5-12, 14-20 and 40 are amended.

2. The double patenting rejection of Claim 25 in the previous Office Action (Paper No. 0903) is removed.

3. Claim objection in the previous Office Action (Paper No. 0903) is removed.

4. Claim rejections under 35 USC 112 in the previous Office Action (Paper No. 0903) are removed.

5. Claim rejections of Claims 40-44 under 35 USC 102 (b) set forth in paragraphs 7-16 of the previous Office Action (Paper No. 0903) are removed.

6. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0903).

Claim Rejections - 35 USC § 102

7. Rejection of Claims 1-4, 27-29 and 34-36 under 35 USC 102(b) as being anticipated by Fujikke (JP 09-143210) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 0903.

Responsive to arguments regarding 35 USC § 103 rejection

8. Applicant's arguments filed on December 31, 2003 have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

The Applicants' principal argument against the rejection is that "The polymer of formula (2) with polyethylene glycol as disclosed in paragraph [0030] of Fujikake is different from the polymer of claim 1 of the present invention. The cross-linking agent polyglycol di(meth)acrylate as used in Fujikake is optional, and is used in a very small amount, in order not to compromise the water absorption ability of the polymer of Fujikake. See paragraph [0051] of Fujikake. As a result, the polymerized product of Fujikake is not highly crosslinked, or even not crosslinked at all. That is the reason why it can be used personal care tissue and electric cables, etc., which require the materials to be supple."

It appears to Examiner that the aforementioned "[0030]" should reads "[0021]" because paragraph [0030] does not recite "formula (2)". Note that Fujikake's formula (2) does read on Applicants' formula (I) wherein Z is a carbamate function. Although Fujikake's poly[ethylene]glycol di(meth)acrylate is optional, Fujikake does teach the use of polyethylene glycol di(meth)acrylate. Furthermore, the present invention does not recite the amount of formula (II) or the characteristics of the final product. Therefore, the argument of the amount of Fujikake's polyethylene glycol di(meth)acrylate and the characteristics of the final product obtained is irrelevant.

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9. Claims 5-26, 30-33 and 37-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the references mentioned in the previous Office action teaches or fairly suggests a) a difunctional monomer of formula (IV); b) the monomers set forth in Claim 12 and other similar claims reciting the same monomers; or c) a photochromic colorant.

Allowable Subject Matter

10. Claims 40-45 are allowed.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp
February 17, 2004


Kuo-Liang Peng
Primary Examiner
Art Unit 1712